

REMARKS

In a Notice of Appeal filed November 30, 2001, the applicants indicated intent to appeal the Examiner's July 30, 2001, Office Action finally rejecting claims 1-36. An Appeal Brief was filed March 14, 2002. On May 6, 2002, the Examiner issued a Notification of Non-Compliance With CFR 1.192(c) (the "Notification"). The Notification alleged various bases for non-compliance of Applicant's Appeal Brief.

Pursuant to Rule 1.192(d), appellants have submitted an Amended Appellant's Brief, which addresses the 1.192(c)(7) defect. The alleged defects under subsections 3, 6, and 8 of Rule 1.192(c) are traversed below.

**APPEAL BRIEF COMPLIANT WITH RULE 1.192(c), SUBSECTIONS 3, 6, AND 8**

On the PTO-462 form, and without remark, the Notification alleged that the Brief does not comply with 1.192(c)(3). Rule 1.192(c)(3) requires the Brief to state "the status of all the claims, pending or cancelled, and identify the claims appealed." Section III of the brief clearly indicates the pending status, rejected status, and appealed status of all of pending claims 1-36. Pursuant to the May 15, 2002 telephone instructions of the Examiner, the 1.192(c)(3) basis for non-compliance has been disregarded.

The Notification alleged that the Brief does not comply with Rule 1.192(c)(6), for failing to address: "the objection"; and "35 USC 112 rejections in the office action". Objections are not appealable to the Board, and the § 112 rejection is fully addressed in Appellant's Brief at section VIII, Group J.

Objections are not appealed to the Board. As stated in MPEP § 706.01:

The practical difference between a rejection and an objection is that a rejection, involving the merits of the claim, is subject to review by the Board of Patent Appeals and Interferences, while an objection, if persisted, may be reviewed only by way of petition to the Commissioner.

**Similarly, the Board will not hear or decide issues pertaining to objections and formal matters which are not properly before the Board. These formal matters should not be combined in appeals to the Board.**

Rule 191(c) states that "appeal when taken must be taken from the rejection of all claims

under rejection which the applicant ... proposes to contest." The Board decides appeals to rejections, not objections. There is no rule requiring an Appeal Brief to mention or address objections to claims. Finally, the § 112 rejections are explicitly addressed in the Brief, as discussed in the following paragraph. The Appellant's Brief clearly meets the requirements of stating the status of the claims with respect to appeal.

The Notification alleged that the Brief does not comply with Rule 1.192(c)(8). Group J (claims 5 and 8) in the Arguments section specifically addresses the §112, second paragraph rejection, noting "A character is not being compared to itself, but rather is being compared to ...". This argument specifies the error in the rejection ("A character is not being compared to itself"), and also points out how the claims particularly point out and distinctly claim the invention ("In other words, there are two different characters involved; the characters in an area surrounding the first area, and the character in the second area.").

#### **AMENDED APPEAL BRIEF COMPLIANT WITH RULE 1.192(c)(7)**

The Amended Appellant's Brief now more clearly states that the claims do not stand or fall together (section III), and now includes explanation of the separate patentability of the claims (section VIII). The Amended Appellant's Brief complies with 1.192(c)(7).

#### **CONCLUSION**

Withdrawal of the Notification of Non-Compliance with 37 CFR 1.192(c) and acceptance of the Amended Appellant's Brief is respectfully requested.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**IN THE CLAIMS:**

None of the pending claims are amended herein.